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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

10006308-1

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on October 11, 2005

Signature

Typed or printed name Michael G. Savage

Application Number

09/774,074

Filed

01/31/2001

First Named Inventor

Jian Fan

Art Unit

2624

Examiner

Stephen M. Brinich

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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attorney or agent of record.

Registration number _____

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 32,596

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Telephone number

October 11, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

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*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Patent
Attorney's Docket No. 10006308-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

MAIL STOP AF

Jian Fan et al.

Application No. 09/774,074

Art Unit 2624

Filing Date: 01/31/2001

Examiner Stephen M. Brinich

For: Compound Document Image Compression
Using Multi-Region Two Layer Format

Confirmation No. 1799

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In connection with the Notice of Appeal that accompanies this paper, review of the final rejections in the Office Action mailed on June 10, 2005, in the above-identified application is respectfully requested.

Claims 1-20 stand finally rejected for obviousness over the Fall patent in combination with various ones of the Lermant and Bates patents, and "Applicant's described Background Art", in particular page 4, line 4, of this application.

These rejections are improper because all combinations of Fall, Lermant, Bates, and the "Applicant's described Background Art" omit one or more essential elements needed for a *prima facie* rejection. In particular, none of the cited art discloses that "each region of the plurality of regions corresponds to text having the same color", as recited by Claim 1, for example. The other independent Claims 9 and 17 include comparable recitations.

Applicants' methods for formatting a document (Claim 1) and formatting and compressing information contained within a document (Claim 17) involve a division into

multiple regions that is based on the colors of bodies of text. Such non-arbitrary division serves to preserve text color information at the same time as it eliminates the need for a separate color layer.

The Fall patent discloses that "data objects [like text] are stored . . . corresponding to the bands of the page". Fall patent, col. 10, ll. 35-36. But the correspondence of objects-to-bands disclosed in the Fall patent is precisely the inverse of the correspondence required by the pending claims, i.e., "each region of the plurality of regions corresponds to text having the same color", as recited in Claim 1, for example. This difference between the Fall patent and the pending claims has been pointed out repeatedly during the prosecution of this application.

The Fall patent's "bands" 112 are merely non-overlapping rectangular areas that do not correspond to underlying objects, as is clear from simple inspection of, for example, the Fall patent's FIG. 2d, showing bands 424-1, 424-2 and 424-3. In the Fall patent, it is underlying objects that correspond to the bands. Applicants' inverse of the Fall patent's correspondence serves to preserve text color information at the same time as it eliminates the need for a separate color layer, as explained in this application at page 5, line 3 et seq., among other places.

These omissions of the Fall patent are not remedied by either the Lermant or Bates patents or "Applicant's described Background Art".

The Lermant patent describes determining whether a text object is "black text or other text". See col. 5, ll. 57-59. If the text is black text, the Lermant patent saves "any underlying color background information" with the black text information and provides some kind of means for "combining the color background information with the black text information". See col. 5, ll. 61-65. If the text is "other text", it is processed "in a standard fashion". See col. 5, ll. 59-61.

If the Lermant patent had been combined with the Fall patent, all that could have resulted is the Lermant patent's different processing of "black text" and "other text" in the Fall patent's non-overlapping areas that still have no relation to underlying objects. Black text in different (Fall) non-overlapping areas might have been processed in the same (Lermant) way, but the text would not have determined the division into regions. Thus, the Fall and Lermant patents omit "dividing the document into regions" where

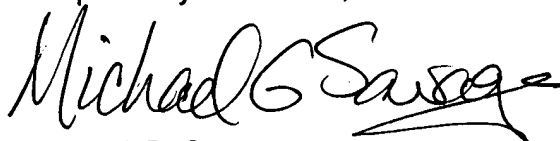
each of a "plurality of the regions corresponds to text having the same color" as recited in Claim 1, for example.

The Bates patent describes selecting and applying a color combination for text and background based on a current color combination in order to replace a problem color combination with a preferred color combination. See Abstract. A combination of the Bates and Fall patents would have had the Fall patent's non-overlapping areas that have no relation to underlying objects, but with color combinations within the Fall patent's areas being adjusted as in the Bates patent. This would have been merely an after-the-fact adjustment that, like the combination of the Fall and Lermant patents, omits "dividing the document into regions" where each of a "plurality of the regions corresponds to text having the same color" as recited in Claim 1, for example.

It is also believed that the cited documents would not have supplied any motivation to combine them as suggested by the Action and that there would have been no reasonable expectation that such complex documents could be successfully combined to yield a working system, which even then would have had to be further modified to obtain the claimed subject matter. In view of the significant differences between the subject matters claimed and the citations, it is unnecessary to discuss in detail these other requirements of a *prima facie* case of obviousness.

Accordingly, it is respectfully submitted that no combination of Fall, Lermant, Bates, and "Applicant's described Background art" discloses all of the features required by Applicants' claims. the obviousness rejections be reconsidered and withdrawn and that this application be allowed. If the Examiner has any questions, the undersigned attorney may be telephoned at the number given below.

Respectfully submitted,



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